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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,719	03/27/2001	Rangachari Anand	YOR920000177US1	1335
7590 06/20/2006 Whitham Curtis & Christofferson P C Suite 340 11491 Sunset Hills Road Reston, VA 20190			EXAMINER GART, MATTHEW S	
			ART UNIT 3625	PAPER NUMBER

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/818,719		ANAND ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Matthew S. Gart		3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Prosecution History Summary***

Claims 1-10 and 12-14 have been canceled in the instant application.

Claims 11, 15 and 16 are currently rejected in the instant application.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 11, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by DeFrancesco (Patent Application Publication No. 2003/0101133).**

The Examiner notes, the specification as originally filed neither redefines the term “State Machine,” nor sets forth an uncommon definition so as to put one reasonable skilled in the art on notice that the applicant intended to so redefine the term “State Machine.” Limitations appearing in the specification but not recited in the claims are not read into the claims. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily).

The term “State Machine” in the claims is to be defined by using its common meaning as understood by a person of experience in the field of the invention.

*Whatis.com* defines a “State Machine” as any device that stores the status of something at a given time and can operate on input to change the status and/or cause an action or output to take place for any given change. *Whatis.com* further states that a computer is

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basically a state machine. For the purpose of examination, a “State Machine” will be given is broadest reasonable interpretation (i.e. a computer) in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

Referring to claim 11. DeFrancesco discloses a system for executing a business process represented as a state machine running on a computing system (DeFrancesco: paragraph 0110), where transitions of the state machine represent roles of participants in the business process and actions that can be taken as part of the business process, and states of the state machine represent stages in the business process where the business process is waiting for an event to occur (DeFrancesco: at least paragraph 0058 and 0059), the system comprising:

- A computer code representation of a state machine representing a business process to be implemented (DeFrancesco: at least paragraph 0110);
- A graphical user interface (GUI) used to view and edit a graphical representation of the state machine representing the business process (DeFrancesco: at least paragraph 0038), wherein business processes can be created and modified by changing, adding, and/or removing states and transitions from the state machine representation of the business processes using the GUI and once the graphical representation is modified, a newly depicted state machine code representation is generated by computer software (DeFrancesco: at least paragraph 0092);

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- A commerce flow engine which stores and executes the state machine representation of the process, including management of process user inputs, wherein when newly created or modified process is compiled, a resulting state machine is loaded for storage in state machine storage and wherein when a user works on a business process, a state machine is retrieved from said state machine storage (DeFrancesco: at least Abstract, "Workflow Management System"), and
- A client on which end user may interact with the system, actions requested by end users being passed to the commerce flow engine which processes client inputs and provides output to the client (DeFrancesco: at least paragraph 0038).

Referring to claim 15. DeFrancesco further discloses a system wherein the particular state machine retrieved from state machine storage depends on the business process, an identity of the client, and other variable criteria, the commerce flow engine including a storage of a current state of a process instance and processing of client inputs depending on the current state of the process instance and a role of the action requester (DeFrancesco: at least paragraph 0061).

Referring to claim 16. DeFrancesco further discloses a system wherein end users interact with the system by means of a web browser operating on the client (DeFrancesco: at least paragraph 0034).

***Response to Arguments***

Applicant's arguments filed 4/6/2006 have been fully considered but they are not persuasive.

The Examiner notes, the specification as originally filed neither redefines the term "State Machine," nor sets forth an uncommon definition so as to put one reasonable skilled in the art on notice that the applicant intended to so redefine the term "State Machine." Limitations appearing in the specification but not recited in the claims are not read into the claims. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily).

The term "State Machine" in the claims is to be defined by using its common meaning as understood by a person of experience in the field of the invention. *Whatis.com* defines a "State Machine" as any device that stores the status of something at a given time and can operate on input to change the status and/or cause an action or output to take place for any given change. *Whatis.com* further states that a computer is basically a state machine. For the purpose of examination, a "State Machine" will be given its broadest reasonable interpretation (i.e. a computer) in light of the supporting disclosure. In *re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

The Applicant notes, "...there is no basis for concluding that the *Whatis.com* definition represents the plain meaning of 'State Machine' given to the term by those of ordinary skill in the art." For purpose of completeness, the *Authoritative Dictionary of IEEE Standards Terms, seventh edition, published by Standards Information Network IEEE press*, defines a "State Machine" as a model of a system in which all values are discrete, as in a digital computer. A copy of this supplemental definition is attached in Appendix A. This definition, provided by a technical reference conforms with the previous definition cited by *Whatis.com*, and supports the position that given it's broadest reasonable interpretation in light of the supporting disclosure a "State Machine" can be construed simply as a computer.

The Applicant notes, "The Examiner recognizes that the DeFrancesco reference does not show or suggest anything with respect to representing a business process as a state machine, as is required by the claims..."

To the contrary, the Examiner clearly referenced paragraph 0110 of DeFrancesco in the prior non-final rejection. Paragraph 0110 states, "...in another embodiment, the invention is implemented primarily in hardware using, for example, hardware components such as application specific integrated circuits (ASICs). Implementation of the hardware state machine so as to perform the functions described herein will be apparent to persons skilled in the relevant art(s)." DeFrancesco is elaborating upon the disclosed workflow management process, whereby the process can be implemented in a variety of ways, one of those ways utilizing a "State Machine."



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Paragraph 0110 recites evidence which anticipates the representation of a business process as a state machine, as required by the claims of the instant invention. Even though DeFrancesco anticipates the instant invention as indicated supra, for the purpose of examination and as indicated previously, the claimed "State Machine" must be given its broadest reasonable interpretation (i.e. a computer) in light of the supporting disclosure.

The Applicant notes, "...it (DeFrancesco) does not show or suggest 'a computer code representation of a state machine representing a business process', or editing the 'the state machine representing the business process', or having a newly created or modified process be compiled, and the resulting state machine being stored for use. All that DeFrancesco describes is an automated credit application system which allows different workgroups to process simultaneously and allows the ability to check the status of active steps."

The Examiner notes, the Applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Gart whose telephone number is 571-273-3955. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763 . The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MSG  
Primary Examiner  
June 16, 2006

## **APPENDIX A**